

REMARKS

This reply is fully responsive to the Office Action dated January 14, 2009, and is filed along with a Petition to Revive and an Request for Continued Examination. The method of payment and fees for petition fee due in connection therewith is enclosed.

Objection/Rejection Summary

This application has been carefully reviewed in light of the Office Action of January 14, 2009, wherein:

- A. Claims 1, 3, 4, 7-19, 58, 59, and 61-65 were rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter;
- B. Claims 1, 3, 4, 11, 12, 58, 59, and 62-64 were rejected under 102(b) as being anticipated by Shimomura et al.;
- C. Claims 1, 11, 19, 20, 23, 30, 31, 33, 38, 39, 41, 42, 49, 50, 57, 66, 67, 70-72, 74, 75, and 78-80 were rejected under 103(a) as being unpatentable over Shimomura in view of Kanehisa;
- D. Claims 1, 4, 9, 10, 13, and 14 were rejected under 103(a) as being unpatentable over Shimomura in view of Walker;
- E. Claims 1, 11, 13-18, 58, 62, 63, and 65 were rejected under 103(a) as being unpatentable over Shimomura in view of Caron;
- F. Claims 20, 23, 28-32, 42, and 47-51 were rejected under 103(a) as being unpatentable over Shimomura in view of Kanehisa and further in view of Walker;
- G. Claims 20, 23, 33-37, 39, 52-56, 66, 72-74, 78, 80 and 81 were rejected under 103(a) as being unpatentable over Shimomura in view of Kanehisa and further in view of Caron;
- H. Claims 7, 8, 26, 27, 45, 46, 61, 69, and 77 were objected to but would be allowed if rewritten into independent form.

Claim Rejections – 35 U.S.C. §101

- A. **Turning now to the Office Action, Claims 1, 3, 4, 7-19, 58, 59, and 61-65 were rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

The Examiner rejected Claims 1, 3, 4, 7-19, 58, 59, and 61-65 under 35 U.S.C. 101 as being directed to non-statutory subject matter, stating that a process is statutory subject matter if it is (1) tied to a particular machine or apparatus (2) OR transforms an article to a different state or thing. *In re Bilski*, 545 F.3d 943, 88 U.S.P.Q.2d 1385 (2008). In the present case, the Examiner stated that the claimed subject matter is not limited to a particular apparatus or machine and that the claims should require the use of a machine within the steps.

The Applicant directs the Examiner to Currently Amended Claims 7 and 61, which now have the language originally presented in Claims 1 and 58, and which have been amended to include the act of causing a processor to perform the listed acts, including determining, with the processor, a first gene expression pattern. Thus, because the claims now require the use of a processor, they are tied to a particular machine. Thus, because Claims 7 and 61 (and any claims depending therefrom) are now tied to a particular machine, they are considered statutory subject matter within the meaning of §101 and in accordance with *In re Bilski*.

Thus, the Applicant respectfully requests that the Examiner withdraw this rejection and provide for timely allowance of the claims.

Claim Rejections – 35 U.S.C. §102

- B. Claims 1, 3, 4, 11, 12, 58, 59, and 62-64 were rejected under 102(b) as being anticipated by Shimomura et al.**

The claims have been cancelled. Thus, the Applicant respectfully requests that the Examiner withdraw this rejection and provide for timely allowance of the remaining claims.

Claim Rejections – 35 U.S.C. §103

- C. Claims 1, 11, 19, 20, 23, 30, 31, 33, 38, 39, 41, 42, 49, 50, 57, 66, 67, 70-72, 74, 75, and 78-80 were rejected under 103(a) as being unpatentable over Shimomura in view of Kanehisa.**

The claims have been cancelled. Thus, the Applicant respectfully requests that the Examiner withdraw this rejection and provide for timely allowance of the remaining claims.

- D. Claims 1, 4, 9, 10, 13, and 14 were rejected under 103(a) as being unpatentable over Shimomura in view of Walker.**

The claims have been cancelled. Thus, the Applicant respectfully requests that the Examiner withdraw this rejection and provide for timely allowance of the remaining claims.

- E. Claims 1, 11, 13-18, 58, 62, 63, and 65 were rejected under 103(a) as being unpatentable over Shimomura in view of Caron.**

The claims have been cancelled. Thus, the Applicant respectfully requests that the Examiner withdraw this rejection and provide for timely allowance of the remaining claims.

- F. Claims 20, 23, 28-32, 42, and 47-51 were rejected under 103(a) as being unpatentable over Shimomura in view of Kanehisa and further in view of Walker.**

The claims have been cancelled. Thus, the Applicant respectfully requests that the Examiner withdraw this rejection and provide for timely allowance of the remaining claims.

- G. Claims 20, 23, 33-37, 39, 52-56, 66, 72-74, 78, 80 and 81 were rejected under 103(a) as being unpatentable over Shimomura in view of Kanehisa and further in view of Caron.**

The claims have been cancelled. Thus, the Applicant respectfully requests that the Examiner withdraw this rejection and provide for timely allowance of the remaining claims.

Allowable Subject Matter

- H. Claims 7, 8, 26, 27, 45, 46, 61, 69, and 77 were objected to but would be allowed if rewritten into independent form.**

With respect to Claims 7, 8, 26, 27, 45, 46, 61, 69, and 77, the Examiner stated that the claims were not rejected based on prior art and would be allowable if amended into independent form. The Applicant has amended the claims per the Examiner's statement of allowable subject matter and respectfully requests that the Examiner withdraw all rejections and provide for timely allowance of the application.

CONCLUSION

The Applicant respectfully submits that in light of the above amendment/remarks, all claims are now in allowable condition. The Applicant thus respectfully requests timely allowance of all of the pending claims.

Any claim amendments that are not specifically discussed in the above remarks are not made for patentability purposes, and it is believed that the claims would satisfy the statutory requirements for patentability without the entry of such amendments. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those skilled in the art to clearly understand the scope of the claim language. Furthermore, any new claims presented above are of course intended to avoid the prior art, but are not intended as replacements or substitutes of any cancelled claims. They are simply additional specific statements of inventive concepts described in the application as originally filed.

Further, it should be noted that amendment(s) to any claim is intended to comply with the requirements of the Office Action in order to elicit an early allowance, and is not intended to prejudice Applicant's rights or in any way to create an estoppel preventing Applicant from arguing allowability of the originally filed claim in further off-spring applications.

In the event the Examiner wishes to discuss any aspect of this response, or believes that a conversation with either Applicant's or Applicants' representative would be beneficial, the Examiner is encouraged to contact the undersigned at the telephone number indicated below.

The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to the attached credit card form. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed. The petition fee due

in connection therewith may be charged to deposit account no. 50-2691 if a credit card form has not been included with this correspondence, or if the credit card could not be charged.

Respectfully submitted,

/Marcus Risso/

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